

### **REMARKS/ARGUMENTS**

Claims 1-10 are pending in the present application. In the Office Action mailed January 10, 2006, the Examiner rejected claims 1-10 under 35 U.S.C. § 103. In the above amendments, claims 1 and 8 have been amended, and new claim 11 has been added.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

#### **A. Rejection of Claims 1-4 and 7-8 Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-4 and 7-8 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,937,232 to Taguchi et al. (hereinafter, "Taguchi") in view of U.S. Patent No. 5,973,802 to Hirota et al. (hereinafter, "Hirota") and further in view of U.S. Patent No. 5,913,014 to Gilman, Jr. et al. (hereinafter, "Gilman"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claim 1 recites "automatically selecting a transform based upon ... user input." Claim 8 recites "automatic selection of a transform based upon ... user input." Claims 1 and 8 have been amended to recite "wherein the received user input is not a selection of a transform." Support for this amendment may be found in original claims 1 and 8 and throughout Applicants' specification, such as on page 3, lines 15-19.

Applicants respectfully submit that the Examiner's proposed combination of Taguchi, Hirota, and Gilman does not disclose, teach, or suggest all of the limitations in claims 1 and 8. Specifically, none of the cited references disclose, teach, or suggest "automatic[ally] select[ing] ... a transform based upon ... user input" that "is not a selection of a transform," as recited in claims 1 and 8.

In the Office Action, the Examiner asserts that "Taguchi discloses ... selection of a transform based upon user input." Office Action, page 3. The Examiner cites the following portion of Taguchi in support of this assertion:

Selection of the  $\gamma$ -curve as described above is fixed by pressing down a  $\gamma$ -curve select key, executing white/black inversion, and then by inputting a  $\gamma$ -curve number with the ten-key, and depressing a # key. The execution of the scanner  $\gamma$ -correction confirming display is started by pressing down the "Enter key".

Taguchi, col. 13, lines 3-8. Thus, the Examiner appears to be taking the position that the " $\gamma$ -curve" disclosed in Taguchi is the "transform" recited in claims 1 and 8. The Examiner also appears to be taking the position that "pressing down a  $\gamma$ -curve select key" is the "user input" recited in claims 1 and 8.

The Examiner correctly points out that Taguchi "does not disclose expressly that said step of selecting is performed automatically." Office Action, page 3. In addition, Applicants respectfully submit that Taguchi does not disclose, teach, or suggest that the transform is automatically selected "based upon ... user input" that "is not a selection of a transform," as recited in claims 1 and 8. As stated above, Taguchi discloses that the gamma curve is selected by a user "pressing down a  $\gamma$ -curve select key." Taguchi, col. 13, line 8. Thus, in Taguchi the user is required to select the  $\gamma$ -curve that is used. In contrast, claims 1 and 8 do not require the user to select the transform to be used.

Instead, the user simply inputs "a color adjustment for a color original" (e.g., an input to boost the colors, an input to reduce the colors, etc.), and this user input is then used to "automatically select[] a transform" that is applied to color values.

Hirota does not make up for the deficiencies of Taguchi. The Examiner asserts that "Hirota discloses automatically selecting a transform, specifically a gamma curve." Office Action, page 3. In support of this assertion, the Examiner cites the following portion of Hirota:

A gamma correction/color balance section 150 controls a gamma curve (gradation correction curve) and color balance of C, M, Y and Bk data automatically or according to instruction given by the operational panel 154.

Hirota, col. 5, lines 40-43 (emphasis added). Thus, Hirota merely discloses that control is either automatic or according to user instructions. However, Hirota does not disclose, teach, or suggest that the transform is selected "automatically ... based upon ... user input" that "is not a selection of a transform," as recited in claims 1 and 8.

Gilman does not make up for the deficiencies of Taguchi and Hirota. Applicants cannot find, nor has the Examiner cited, any portion of Gilman that discloses, teaches, or suggests "automatically selecting a transform based upon ... user input" that "is not a selection of a transform," as recited in claims 1 and 8.

In view of the foregoing, Applicants respectfully submit that the Examiner's proposed combination of Taguchi, Hirota, and Gilman, does not disclose, teach, or suggest all the limitations in amended claims 1 and 8. Accordingly, Applicants respectfully request that the rejection of claims 1 and 8 be withdrawn.

Claims 2-4 and 7 depend directly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-4 and 8 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 8.

B. Rejection of Claims 5 and 6 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) based on Taguchi in view of Hirota, Gilman, and U.S. Patent No. 5,737,032 to Stenzel et al. (hereinafter "Stenzel"). This rejection is respectfully traversed.

The standard for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is provided above. Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claims 5 and 6 depend from claim 1. As shown above, the Examiner's proposed combination of Taguchi, Hirota, and Gilman does not disclose, teach, or suggest "automatically selecting a transform based upon ... user input" that "is not a selection of a transform," as recited in claim 1. Likewise, the Examiner has not cited, nor can Applicants find, any portion of Stenzel that discloses, teaches, or suggests this claim limitation. Accordingly, Applicants respectfully request that the rejection of claims 5 and 6 be withdrawn.

C. Rejection of Claims 9 and 10 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 103(a) based on Taguchi in view of Hirota, Gilman, and U.S. Patent No. 5,666,293 to Metz et al. (hereinafter "Metz"). This rejection is respectfully traversed.

The standard for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is provided above. Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claims 9 and 10 depend from claim 8. As shown above, the Examiner's proposed combination of Taguchi, Hirota, and Gilman does not disclose, teach, or suggest "automatic selection of a transform based upon ... user input" that "is not a selection of a transform," as recited in claim 8. Likewise, Applicants cannot find, nor has the Examiner cited, any portion of Metz that discloses,

teaches, or suggests this claim limitation. Accordingly, Applicants respectfully request that the rejection of claims 9 and 10 be withdrawn.

D. New Claim 11

New claim 11 has been added. Applicants respectfully submit that claim 11 is patentably distinct from the cited references. The cited references do not disclose, teach, or suggest all of the limitations in this claim.

Claim 11 recites "automatically selecting a transform based upon ... user input" that "is not a selection of a transform." Support for this claim limitation may be found in original claims 1 and 8 and throughout Applicants' specification, such as on page 3, lines 15-19. As shown above, none of the cited references discloses, teaches, or suggests this claim limitation.

Claim 11 also recites "the selection of transform functions comprises at least one sigmoidal-shaped curve, wherein the available selection transform functions share a common midpoint." Support for this claim limitation may be found throughout Applicants' specification, such as on page 4, lines 19-20 and in Figure 3. Applicants submit that none of the cited references, alone or in combination, discloses, teaches, or suggests this claim limitation.

In the Office Action, the Examiner asserts that "Gilman discloses a transform function ... [that] comprises at least one sigmoidal-shaped curve...." Office Action, page 4. The Examiner cited to Gilman's Figure 9 as teaching a sigmoidal-shaped curve. Id. However, the midpoints of the various curves in Figure 9 are not shared. Rather, the midpoints move up the visual density axis as the shoulder portion of the aim curve is pushed higher. See id. at col. 5, lines 35-48. Therefore, Gilman does not disclose, teach, or suggest that "the available selection transform functions share a common midpoint," as recited in claim 11. Furthermore, the Examiner has not cited, nor can Applicants find, any portion of Taguchi, Hirota, Stenzel, or Metz that discloses, teaches, or suggests this limitation.

Finally, claim 11 recites "the transform function is a difference function of two exponential functions." Support for this claim limitation may be found in Applicants' specification on page 5,

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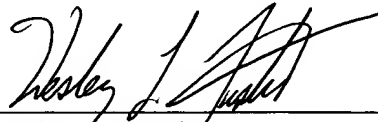
lines 1-2. Though the Examiner has sited Stenzel as disclosing a piecewise linear function, Applicants respectfully submit that they cannot find any portion of the cited references that discloses, teaches, or suggests that "the transform function is a difference function of two exponential functions," as recited in claim 11.

In view of the foregoing, Applicants respectfully submit that the cited references do not disclose, teach, or suggest all of the limitations in claim 11. Accordingly, Applicants respectfully request allowance of claim 11.

E. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', is written over a horizontal line.

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